

Examiner rejected claims 4 and 20 under 35 USC 103 as being unpatentable over Moerkens and Kastl et al. ("Kastl").

Applicant traverses these rejections for the following reasons.

(a) In holding original claims 4 and 20 as mere obvious modifications of Moerkens in view of the teachings of Kastl, Examiner inherently takes the position that:

(i) Moerkens' ballasting circuit is functional if powered from a high-frequency (i.e., 20 kHz) voltage versus being powered by ordinary low-frequency (i.e., 60 Hz) power line voltage; and

(ii) there is a benefit associated with powering Moerkens' ballasting circuit from a high-frequency voltage.

However, in actual fact, Examiner has provided no evidence whatsoever to the effect that: (i) it is feasible to power Moerkens' ballasting circuit from a high-frequency voltage; and (ii) there is a benefit associated with doing so.

CONCLUDING REMARKS

To understand the implications of his inherent assumptions and positions, Examiner is asked to carefully read the following discussion.

In holding a claimed invention as representing nothing but obvious modifications of the teachings of a set of applied references, Examiner inherently also holds that effectuating these modifications are not likely to result in any collateral consequences of such nature as to negate the benefits sought by the proposed modifications in the first place.

However, unless it be clear to the skilled artisan that a given modification is not likely to lead to consequences of such nature as to negate any sought-after benefit, the skilled artisan would not find this given modification to be one that he obviously would effectuate. For him to actually effectuate some given modification, it must be clear that such modification will be unlikely to cause collateral consequences of such nature as to negate whatever benefit he might otherwise have expected from the modification.

{Which, of course, is not to say that he might not consider it obvious to try to effectuate this modification. However, as is well established in case law, "obvious to try" is not a proper criterion on basis of which to hold a claimed invention obvious under 35 USC 103.}

Thus, in the absence of evidence to the effect that no collateral consequences (of such nature as to negate the sought-after benefit) are likely to result, it is improper for Examiner to hold Applicant's claimed invention to be unpatentable under 35 USC 103.

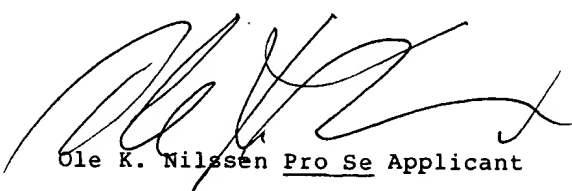
In this connection, Examiner is reminded of the fact that he can not presume himself to possess any particular level of expertise in the art to which the claimed invention pertains; which therefore means that Examiner must refrain from taking any position which inherently would require of him to have such expertise. Thus, Examiner is not in a position to render a meaningful opinion with respect to whether or not a proposed modification is likely to give rise to significant negative collateral consequences, except in situations where the proposed modification is so simple and straightforward as not to require the understanding and experience of a skilled artisan in order to assess its likely impact.

In other words, in case of his proposed modifications of the teachings of the applied references, it would be improper (i.e., intellectually dishonest) for Examiner to take the position that no significant negative collateral consequences are likely to occur, except if it indeed be clear to him that such be the case.

However, in instant case, Examiner inherently does take that position.

Yet, can Examiner honestly make the statement that it is clear to him that no negative consequences (of such nature as to negate any sought-after benefit) are likely to occur as a result of his proposed modifications of the applied prior art teachings?

Unless it be clear to Examiner that a skilled artisan would conclude that no such negative consequences are likely to occur as a result of the modification, it would be dishonest of Examiner to hold that that this same skilled artisan would find it obvious to seek to effectuate this modification.



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